REMARKS/ARGUMENTS

Applicant responds herein to the Office Action dated December 15, 2003.

Claim 1, 3-8, 11, 13, 15, 16-22 and 25 stand rejected on grounds of obviousness over Barritz (5,590,056), in view of Christiano (5,671,412), further in view of Wong. Claim 2 is being rejected on grounds of obviousness over the aforementioned references, further in view of Isman (U.S. patent application publication no. 2002/0023260). Claims 9, 10, 12 and 14 stand rejected over Barritz, Christiano and Wong, further in view of Robert (4,937,863) and claims 23-24 stand rejected over Barritz, Christiano and Wong, further in view of Pettitt (5,864,620). reconsideration is requested in view of the following remarks.

As acknowledged and, indeed, as described in the introductory pages of the instant specification, e.g., page 2, line 19 et.seq., the claimed "second software determines the usage of the software products on the computer over time", constitutes existing technology. One form thereof is represented by the present assignee's SOFTAUDIT product which is described, inter alia, in U.S. patent no. 5,590,056.

Relative to the claimed "first software", the Examiner has relied on the secondary reference, Christiano '412. Respectfully, the applicant's examination of the '412 patent does not disclose any software program that is proactively executed and run to determine the capacity of the computer. Certainly, there is no program disclosed to do so "dynamically over time".

Indeed, if at all, more relevant than Christiano '412 is the description in the opening paragraphs of the instant specification, where applicant describes the prior art LicensePower/MVS computer program available from the assignee of the present invention which product provides the user with the ability to "scale" usage statistics. See the specification at page 2, lines 13-19. In other words, without even resorting to Christiano '412, the instant specification acknowledges the prior art's ability to scale usage statistics based on "static configurations" which include the speed of the computer and other factors.

But as further pointed out at page 3, commencing with line 15 of the instant specification, the prior has never developed the tools that scale and adjust usage information for non-static systems such as encountered in the environment of mainframe computers, where the capacity and the number of different partitions within these systems "can be dynamically changed as processing needs change".

The emphasis in claim 1 is therefore, on running a specific software -- denominated as the "first software" -- to determine the capacity of the computer "dynamically over time" and thereafter, correlating the usage information obtained by the conventional second software with the computer capacity data obtained by the first software "in a manner which restates the results of the software usage data based on dynamic variations over time of the computer capacity data." (emphasis added).

In the first instance, applicant respectfully submits that there is nothing in Christiano '412 that describes any software for determining what that patent refers to as the "environmental resource capacity". Secondly, there is certainly no software which carries out that task to determine an environmental resource capacity "dynamically over time", for the purposes of carrying out the correlation function of the present invention.

At best, Christiano '412 discloses at column 21, commencing at line 34, that: "the environmental resource capacity is preferably determined prior to step 194 by either reading a resource capacity set by the operator of the license management system, or determine the resource capacity using an established method." The reference suggests that this can be done by "examining the current hardware platform or other environmental resource." In effect, Christiano '412 describes an initialization step wherein one looks up the environmental factor and fixes it for the particular license environment. Indeed, the text at column 17, commencing with line 8, suggests that the environmental resource capacity is a set number, for example, the numerals 2 or 1, which is as used as the "scaler" similar to the prior art scaler which is described at the applicant's introductory page, e.g., page 2, lines 13-18.

The difference between the method of claim 1 and the prior art is described in the opening pages of the instant specification as turning on the difference between relying on static configurations and dynamically changing configurations.

On this important aspect, the Examiner merely comments summarily: "Furthermore, although the invention of Barritz and Christiano doesn't specifically disclose restating the results of the software usage data based on the variations over time of the computer capacity data, it would have been obvious to one having ordinary skill in the art to include this limitation, because the combination would have provided accurate usage data to the user, rather than simply adjusting the usage data without notifying the user."

But as noted above, the applicant contends that the environmental scaler has been treated in the prior art as a constant number that is set for a particular operating environment. The prior art did

not perceive of the problem that is typically encountered with mainframe or very large-scale computers where logical partitions and other parameters constantly change the configuration of computers based on dynamic execution of programs and other factors. On this very point, the Examiner is simply relying on logic and purported intuition, alleging that it would have been obvious for one of ordinary skill in the art to bridge the gap between the prior art and the instant invention.

Based on the foregoing remarks, the applicant respectfully traverses the Examiner's statement at page 4 of the Office Action: "Christiano then teaches using the environmental resource capacity number to combine the corresponding usage information with the capacity data to form raw, normalized software data to account for difference in the hardware speed...". In the first instance, the language of claim 1 does not talk about "using" the environmental resource capacity. Rather, the specific language of claim 1 calls for: "running a first software and determining the capacity of the computer dynamically over time and obtaining computer capacity data". No such step or software is provided or disclosed in this reference. As noted above, Christiano teaches no more than setting a parameter within the computer. This is vastly different than recognizing the concept and advantage of running the first software of the present invention. Indeed, the result that one obtains is quite different from the other.

It is not surprising, therefore, that the Examiner is relying in the final analysis on logic, rather than prior art, arguing: "It would have been obvious to one having ordinary skill in the art to modify the invention of Barritz to include obtaining computer capacity data for normalizing the corresponding software usage data, as taught by Christiano, because, as suggested by Christiano, the combination would have fairly adjusted the software usage data to account for actual usage differences caused by platform specifications...". But, respectfully, the prior art suggests that parameter being set when the computer is set up and not dynamically and repetitively over time, as taught by the present invention. Therefore, the combination of references suggested in the Office Action simply does not lead one to the invention as claimed.

Page 5 of the Office Action continues: "As noted above, the invention of Barritz and Christiano teaches many of the features of the claimed invention, and while the combination teaches determining a capacity index of the computer based on parameters such as processor speed, disk drive space, or memory space, the combination does not specifically indicate determining the computer capacity dynamically over time." In the first instance, the applicant disagrees that

Christiano teaches the language of claim 1, which includes running a first software to do so on a dynamic basis. The prior does not teach any such software. It teaches setting a parameter when a system is first set up.

Regardless, the Examiner is turning to Wong for the proposition that it teaches software for implementing a new pricing model based upon processor power, etc.

The applicant's undersigned representative has reviewed the referenced text from Wong and finds nothing there that is relevant to the present invention before the Examiner. The referenced text quotes analyst Mike Sun of Giga Information Group: "Every time you upgrade the machine with more power, Oracle can charge more for it." The overall thrust of the teaching of this reference is, as applicant itself pointed out, that the prior art contemplated that when a system is set up, somebody who knows the capacity of the computer sets a parameter to identify that capacity to a certain program. But nowhere in the prior art is there any teaching of a running software that tests and adjusts that capacity criteria on the fly and in a manner which allows it to happen while the computer is running, as is clearly implicit in the instant invention which runs a computer program on a repetitive basis to calculate that parameter.

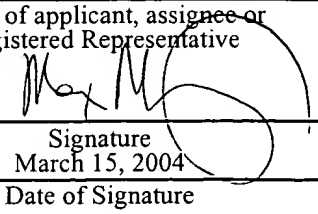
Applicant therefore asserts once again that, to date, the Office Action has not met the terms of claim 1, particularly as presently worded. All the remaining claims in the application contains the limitations of claim and impose further limitations thereon, which places them even further away from the prior art. Therefore, all of the claims in the application are clearly patentable over the prior art.

The Examiner is respectfully requested to reconsider the application, allow the claims and pass this case to issue.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on March 15, 2004

Max Moskowitz

Name of applicant, assignee or Registered Representative

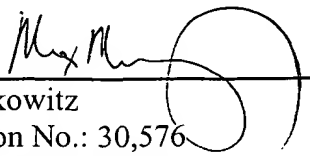


Signature

March 15, 2004

Date of Signature

Respectfully submitted,



Max Moskowitz
Registration No.: 30,576
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700